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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,598	08/21/2003	William A. Cook	33116.68	9797
32300	7590	01/24/2005	EXAMINER	
BRIGGS AND MORGAN, P.A.			NGUYEN, CAMTU TRAN	
2200 IDS CENTER			ART UNIT	
MINNEAPOLIS, MN 55402			PAPER NUMBER	

3743

DATE MAILED: 01/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n No.

10/646,598

Applicant(s)

COOK ET AL.

Examin r

Camtu T. Nguyen

Art Unit

3743

-- Th MAILING DATE of this communication app ars n th cov r sh et with th corr sp nd nc address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) 5-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of the first species, claims 1-4, in the reply filed on December 10, 2004 is acknowledged.

Claims 5-11 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Elliott (U.S. Patent No. 6,417,764). Elliott discloses in Figure 3 a storage case for an orthodontic retainer and the like comprising elements as recited in this claim.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Wise (U.S. Patent No. 6,082,995). Wise discloses in Figure 3 a carrier (28) comprising elements as recited in these claims including a base (30), a lid (32), upwardly protruding, arcuate wall (40) corresponding to the innermost wall of the perform (10).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kittelsen et al (U.S. Patent No. 5,234,005) in view of Wise (U.S. Patent No. 6,082,995).

Kittelsen et al discloses in Figures 1-20 a protective mouthguard assembly (10) comprising elements as recited in these claims including a storage case top section (25), a storage case bottom section (26), a mouthguard (11) having a connecting tab (12) integrally formed therefrom, the connecting tab (12) is provided with a first attachment means in the form of an attachment opening (21), a tether (14) having an attachment means in the form of the tether bead (15) for selective attachment to and detach from the connecting tab (12). Figure 10 illustrating the storage case for the mouthguard (11). Figures 14-16 illustrating a strap member (41) that has a bead (39) at one end and an aperture (44) at the other end. The bead (39) can pass through aperture (44) in order to fasten the mouthpiece portion (11) to a helmet (column 5 lines 57-62).

The Kittelsen et al assembly does not appear to suggest a partition oriented to engage the mouthguard. Wise discloses in Figure 3 a carrier (28) comprising elements as recited in these claims including a base (30), a lid (32), upwardly protruding, arcuate wall (40) corresponding to the innermost wall of the perform (10). Therefore it would have been obvious to one skilled in art to include upwardly protruding, arcuate wall in Kittelsen et al's storage case, as suggested by Wise, for the purpose of preventing movement of the mouthguard in the storage case.

Art Unit: 3743

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kittelsen et al (U.S. Patent No. 5,234,005) in view of Pratt (U.S. Patent No. 5,323,787). Kittelsen et al, as modified above, discloses in Figures 1-20 a protective mouthguard assembly (10) comprising elements as recited in these claims but lacks the teaching of the storage case impregnated with an antimicrobial agent. Pratt discloses in Figure 1 a mouthpiece (10) stored in a U-shaped container (14) having a cover (16). Pratt further discloses the U-shaped base member of container (14) is supplied with sterilizing (bactericides) mixture (28). Therefore, it would have been obvious to one of ordinary skill in the art to fill or to saturate the Kittelsen et al's storage with Pratt's sterilizing mixture for the purpose of preventing growth of bacteria or microbes.

### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

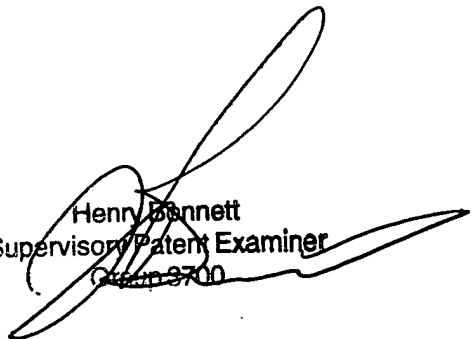
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Camtu T. Nguyen whose telephone number is 703-305-0537. The examiner can normally be reached on (M-F) 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett can be reached on 703-308-0101. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3743

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Camtu Nguyen  
December 28, 2004



Henry Bennett  
Supervisory Patent Examiner  
Group 3700